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signal of digitized video [signal] data and/or a signal of
audio [signal] data, said operation comprising:

reproducing the information concerning copying consent
superimposed on the video data and/or audio data;

determining whether the medium to be reproduced is a
medium dedicated to reproduction or a recordable medium; and

stopping reproduction in response to information
reproduced by said information reproducing step indicating
that copying once was permitted and a result of said
determining step indicating a medium dedicated to
reproduction.

REMARKS

By the above amendment, the claims have been amended in a
manner which is considered to overcome the objections as set
forth by the Examiner to correct minor informalities and to
utilize consistent wording in terms of "data" throughout. As
such, the objections to claims 1-16 should now be overcome.

The rejection of claims 1-7 and 14-16 under 35 U.S.C.
§103(a) as being unpatentable over Tozaki et al in view of Omi
et al; the rejection of claims 8 and 9 under 35 U.S.C. §103(a)
as being unpatentable over Tozaki et al in view of Takemura et
al; the rejection of claim 10 under 35 U.S.C. §103(a) as being
unpatentable over Tozaki et al in view of Doi; the rejection
of claim 11 under 35 U.S.C. §103(a) as being unpatentable over

Tozaki et al in view of Doi and in view of Takemura et al; the rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Tozaki et al in view of Yokota et al and of Fox; and the rejection of claim 13 under 35 U.S.C. §103(a) as being unpatentable over Tozaki et al in view of Yokota et al, Fox and Takemura et al; all such rejections are traversed, and reconsideration and withdrawal of the rejections are respectfully requested.

At the outset, applicants note that the present invention is directed to a reproduction apparatus, method and computer-readable program encoded in a memory medium for prohibiting reproduction of video data and/or audio data recorded in a medium dedicated to reproduction or a recordable medium having such data recorded thereon, where such reproduction should not be permitted, even though the information indicates that one time reproduction is permitted. That is, in accordance with the present invention, reproduction is prohibited and other features such as destruction of data is enabled when two factors are determined to exist. Each of the independent claims of this application recite two factors which exist, including one factor that the information reproduced by a reproducing unit indicates that copying once was permitted and a second factor as recited in each of the independent claims and the dependent claims of claims 1-11 and 14-16, that the medium to be reproduced is a medium dedicated to reproduction.

Independent claims 12 and 13, while prohibiting reproduction in accordance with one factor that copying once was permitted utilizes a different second factor or a third factor relating to detection of wobbled grooves. However, in all instances, at least two factors are utilized in determining whether or not reproduction is prohibited or stopped, as recited in each of the independent claims of this application. Thus, when a reproducing apparatus in accordance with the present invention detects from a disk to reproduced, that information indicative of copy permitted only once exist in a reproduction-only disk, the reproducing apparatus further determines the disk to be unauthorized from copying (based on a recognition that data subject to copy permitted only once cannot exist in other than a recordable (writable) disk as an authorized copy).

Therefore, the present invention determines that the disk is prohibited from being reproduced even though the disk contains information indicative of copying being permitted only once. In this manner, reproduction of a piracy-copy disk is disabled and consequently prohibited. Irrespective of the contentions by the Examiner, applicants submit that the cited art taken alone or in any combination fails to disclose or teach the claimed features as set forth in the independent and dependent claims of this application, and the rejection as set forth by the Examiner only comes about by way of a hindsight reconstruction attempt.

Reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Turning to Tozaki et al, the Examiner recognizes that "Tozaki et al do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium" and additionally, although not pointed out by the Examiner, Tozaki et al do not disclose or teach that reproduction is stopped or prohibited when it is determined that the medium is dedicated to reproduction together with another factor. Applicants note that Tozaki et al discloses that appended information such as

"copy prohibited, copy permitted only once and copy permitted for unlimited times" is added to data recorded on a disk, and arranged in a hierarchical manner, whereby a duplicating process of the recorded data is prohibited or permitted in accordance with the appended information. Although the Examiner contends in relation to claim 1, for example, that Tozaki et al discloses "a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (col. 21, lines 14-27)" (emphasis added), applicants submit that the Examiner has misinterpreted this portion of the Tozaki et al disclosure. Col. 21, lines 14-27, provides:

As described above, in the present invention, the copy flags are recorded on a plurality of hierarchical layers. Therefore, the copy is immediately started if all of the information units selected by the user are set copy-permitted while the copy is not started and the user is notified the copy prohibition of the selected information if all of the information units selected by the user are set copy-prohibited. Therefore, it is possible to avoid performing the copy in vain. Further, if the information unit selected by the user include both the copy-prohibited information and the copy-permitted information, the system notifies of it to the user and manages the copy operation according to the further instruction from the user, thereby enabling the copy management to meet the user's demand. (emphasis added)

Applicants submit that in accordance with Tozaki et al, an indication of copy only once is copy-permitted information and

only when the copy flag is set from the copy only once information to copy prohibited information is the copying prohibited. Thus, contrary to the position set forth by the Examiner, information that copy only once is permitted represents copying being enabled and applicants submit that contrary to the Examiner's position, Tozaki et al do not disclose stopping copying of information when the information indicates that copying once was permitted, as recited in each of the independent claims of this application. Thus, applicants submit that the Examiner has mischaracterized the disclosure of Tozaki et al and Tozaki et al fails to disclose or teach in the sense of 35 U.S.C. §103, stopping of copying of information when the information indicates that copying once was permitted, irrespective of the fact that Tozaki et al provides no disclosure or teaching of an additional factor relating to the type of the medium as recited in each of the claims of this application, i.e. a medium dedicated to reproduction and/or a medium with wobbled grooves as being a factor in determining whether or not reproduction is prohibited or enabled. Thus, applicants submit that each of the independent and dependent claims of this application, patentably distinguish over Tozaki et al taken alone or in any combination of references in the sense of 35 U.S.C. §103, and all claims should be considered allowable in this application.

With respect to Omi et al, applicants note that this

patent is directed to a disk recording/reproduction device having reduced thickness with a driving mechanism for moving heads parallel to the disk face. Omi et al do not disclose or teach the stopping of reproduction based upon a determination that the disk medium is a medium dedicated to reproduction.

Rather, Omi et al discloses that in order to prevent erasure of recorded data due to inadvertent operation of a user, the disk recording/reproduction device includes a mechanism for determining whether a record prohibition/permission exist to thereby prohibit recording on a disk in which recording is not permitted. Thus, while the Examiner indicates that Omi et al teaches determining whether a medium is dedicated to reproduction or recording, referring to col. 8, lines 52-67 of such patent, as described therein, the presence or absence of holes in the medium at appropriate locations are utilized to determine whether a medium is a recording/reproduction recording medium or a medium is a reproduction only medium and whether any recording operation is prohibited for the medium as where the medium is write protected. Applicants submit that Omi et al fail to provide any disclosure concerning prohibition of reproduction from a disk which is determined to be a medium dedicated to reproduction. As such, Omi et al fail to disclose the second factor or other factor as pointed out above, which is utilized for the determination of stopping of reproduction and the proposed combination represents a

hindsight reconstruction attempt utilizing the principle of "obvious to try" which is not the standard of 35 U.S.C. §103. See In re Fine, supra. Accordingly, applicants submit that the independent and dependent claims of this application which stand rejected based upon the combination of Tozaki et al and Omi et al patentably distinguish over this proposed combination of references in the sense of 35 U.S.C. §103, and should be considered allowable thereover.

As to the combination of Tozaki et al with the other secondary and tertiary references of Takemura et al, Doi, Yokota et al and Fox, applicants submit that none of these references, like Omi et al, overcome the deficiencies of Tozaki et al as pointed out above, and the proposed combination represents a hindsight reconstruction attempt with the Examiner picking and choosing individual pieces from the cited art in an attempt to meet the claimed combination. Such procedure is not proper under 35 U.S.C. §103. See In re Fine, supra.

That is, none of these references relate to determining of an unauthorized copy and stopping reproduction based upon a plurality of factors which the Examiner concedes is not disclosed by Tozaki et al. Referring to Takemura et al, for example, while this patent teaches detecting a medium identification code, such patent does not provide any disclosure or teaching concerning stopping of reproduction of


information from the medium in the manner disclosed and claimed herein. Likewise, while Doi teaches determining whether a disk is dedicated to reproduction or recording, based on the reflectance of the disk, Doi does not disclose or teach utilization of such information for stopping reproduction in the manner disclosed and claimed herein. With respect to Yokota et al, while this patent does disclose a wobble detection unit, applicants submit that Yokota et al merely discloses recording position information on wobble tracks in order to detect a position on a disk at which a recording or reproduction is performed, such that Yokota et al does not disclose or teach the claimed features of the claims of this application with respect to prohibiting an unauthorized reproduction of the information. As to Fox, this publication discloses preventing piracy by a system which rejects a disk for copying if the disk lacks wobbled grooves. However, Fox provides no disclosure or teaching of such feature in combination with a determination that the disk further includes information that copying once was permitted. As such, it is apparent that the Examiner has engaged in a hindsight reconstruction attempt, and the independent and dependent claims further recite additional features concerning destruction and other features not disclosed or taught by the cited art. As such, applicants submit that all claims patentably distinguish over Tozaki et al taken alone or in any

combination of the other cited art as suggested by the Examiner, and all claims should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that claims 1-16, as amended, should be considered allowable over the cited art, and issuance of a favorable action is respectfully requested.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.37136X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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